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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,833	11/04/2003	William Andrus Williams	02410-0111 (42353-294311)	5773
23370	7590	11/24/2004	EXAMINER NUTTER, NATHAN M	
JOHN S. PRATT, ESQ KILPATRICK STOCKTON, LLP 1100 PEACHTREE STREET ATLANTA, GA 30309			ART UNIT 1711	PAPER NUMBER

DATE MAILED: 11/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/700,833

Applicant(s)

WILLIAMS ET AL.

Examiner

Nathan M. Nutter

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address.

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 and 34-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26 and 37 is/are allowed.
- 6) ☒ Claim(s) 1-25 and 36 is/are rejected.
- 7) ☒ Claim(s) 34 and 35 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

The restriction requirement of 1 October 2004 is hereby withdrawn. Claims 1-26 and 34-37 will be examined together.

### ***Allowable Subject Matter***

Claims 26 and 37 is allowed.

### ***Claim Objections***

Claims 19-24, 34 and 35 are objected to because of the following informalities:  
Claims 19-23 are drawn to a method for producing a latex article, yet depend ultimately from claim 1 drawn to a "method of making an elastomeric formulation." This is not a method of producing a formed article. Further, claim 24 is drawn to a composition, yet depends from claim 1 drawn to a method. Claims 34 and 35 depend from cancelled claims 27 and 33, respectively. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-25 and 36 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The recitation in claims 1, 25 and 36 of "a base polymer having carboxyl groups" is not enabled by the teachings of the Specification at page 4, 5<sup>th</sup> full paragraph. That section recites monomers acrylonitrile and isoprene as though they are polymers. Butadiene rubber, neoprene and natural latex rubber do not have carboxylate groups, yet are intended for inclusion of applicants' definition for "a base polymer having carboxyl groups". The determination thereof, for an artisan of ordinary skill in the art, would require the undue burden of experimentation. Further, the recitation in claims 1, 25 and 36 of a "carboxylic acid or derivative(s) thereof" is not enabled by the teachings of the Specification at page 5, 1st full paragraph, since the term is used in derogation of its meaning. The term "carboxylic acid" embraces a class of compounds that may include amino acids and other species either not suitable nor compatible for inclusion. No clear criterion is expounded herein. The Specification, further, states that "(d)erivatives of carboxylic acid include...copolymers, blends and mixtures". A copolymer is NOT a derivative. Again, the determination thereof, for an artisan of ordinary skill in the art, would require the undue burden of experimentation. Further, the recitation in claims 1, 25 and 36 of "a divalent or trivalent metal" is not enabled by the teachings of the Specification at the paragraph bridging page 5 (line 37) to page 6 (line 34) of the Specification since the term is used in derogation of its meaning. The Specification indicates the addition of metal ions and not of metal, *per se*. Again, the determination thereof, for an artisan of ordinary skill in the art, would require the undue burden of experimentation. Further, the recitation in claims 1, 25 and 36 of "an amine or amino compound" is not enabled by the teachings of the Specification at the paragraph

bridging page 6 to page 7 of the Specification since the term is not clearly discussed as to constitution, but, rather as to function, "capable of adjusting the pH of the latex". As such, the determination thereof, for an artisan of ordinary skill in the art, would require the undue burden of experimentation. The further, recitation of "a neutralizing agent" is not enabled by the teachings of the Specification at the paragraph bridging page 4 to page 5 since the term is not disclosed as to its meaning.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-25 and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

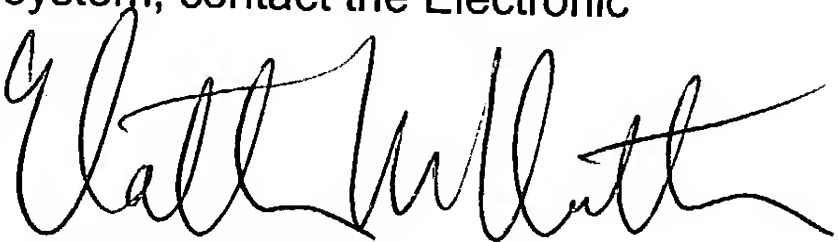
The claims are not clear as to their proper metes and bounds since the terms "a base polymer having carboxyl groups", "a carboxylic acid or derivative thereof", "a divalent or trivalent metal", "an amine or amino compound" and of "a neutralizing agent" are not clear as to either their content or scope as to what may or may not be included. As such, these claims are deemed to be vague and confusing.

The references to Quigley et al ('367), Rowland et al ('635) and Sullivan et al ('803), all cited in the prosecution of the parent application Serial Number 09/903,230, are retained as of interest, but are not deemed to negate the patentability of the instant claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Nathan M. Nutter  
Primary Examiner  
Art Unit 1711

nmn

19 November 2004